

## REMARKS/ARGUMENTS

The rejection of Claims 15 to 19, 21 to 23, 24 and 25, and 27 and 28 in the patent application as being anticipated based on the **HIRAOKA et al. '235** patent under 35 U.S.C.§102(e) is respectfully traversed. Further, the rejection of Claims 15 through 23 in the patent application as being obvious and unpatentable based upon the **OTIS '844** patent in view of the **HIRAOKA et al. '235** patent under 35 U.S.C.§103(a) is also respectfully traversed.

The **HIRAOKA et al. '235** patent discloses a non-slip member capable of being used as an outsole of a shoe and to a manufacturing method of the non-slip member. The non-slip member includes a large number of non-slip convexes that are fixed to an upper surface of a basic fabric performing an anchoring action (generally called “anchoring effect”), characterized in that the non-slip convexes are composed of a rubber.

In the manufacturing method of the non-slip member includes a first step which an unvulcanized rubber is pressed between a metallic mold having a large number of molding concaves corresponding to the non-slip convexes and a holding plate, and the unvulcanized rubber is semi-vulcanized by heating. After the semi-vulcanization, the holding plate is released and burrs not accommodated in the molding concaves of the metallic mold are removed. Thereafter, a base fabric is laid covering a part to be molded serving as the non-slip convexes. By pressuring and heating the part to be molded while laying the base fabric and closing the metallic molds, the part to be molded is vulcanized, and the vulcanized non-slip

convexes are caused to get in the upper surface of the base fabric performing the anchoring action to be fixed thereto. This prior art patent **does not disclose or teach** the structure, configuration and design of a footwear sole and a method of manufacturing the same including the steps of removing excess textile material after the impregnating step; and providing the textile material in the mold before the delivery step.

The **OTIS '844** patent discloses a shoe, especially a slipper having a slip-resistant, shape-retaining outsole. The shoe includes an upper, a lower attached to the upper, and an outsole attached to the lower, the outsole having an outer layer constituted of a fabric material and a backing layer constituted of a shape-retaining material, the outer and backing layers being integrally connected with each other, for example, by being molded in site. . The outer fabric layer provides for increased slip resistance and quieter usage, where the shape-retaining, molded backing layer provides increased shape retention. This prior art patent **does not disclose or teach** the structure, configuration and design of a footwear sole and a method of manufacturing the same including the steps of removing excess textile material after the impregnating step; and providing the textile material in the mold before the delivery step.

The **OTIS '844** patent and the **HIRAOKA et al. '235** patent, even when combined, **do not teach or disclose** the following elements of Amended Independent Claim 15, for a footwear sole and a method for forming the same as follows:

- a) removing excess textile after the impregnating step; and
- b) providing the textile material into the mold before the delivering step.

It **would not** have been obvious to the manufacturer to provide the textile material to the **mold** before the delivering step, as this step is a unique processing step.

Neither of the aforementioned prior art patents of **OTIS** and **HIRAOKA** disclose any step of trimming and removing excess textile material after the impregnating step, nor providing the textile material to the mold before the delivery step.

Therefore, the combination of the **OTIS '844** patent and the **HIRAOKA et al. '235** patent with regard to Claim 15 **do not show, disclose or teach** the specific structure of a footwear sole for a shoe, a slipper or a sandal and the like of the claimed invention.

The **OTIS '844** patent and the **HIRAOKA ET AL. '235** patent, even when combined, **do not teach or disclose** the following elements of Amended Independent Claim 24, for a footwear sole and a method for forming the same as follows:

a) forming at least one outer sole including at least partially impregnating a rubber-free, woven natural textile material into at least a portion of at least one surface of at least one inner sole so that only the textile material is exposed on an outer surface of a sole of the footwear article corresponding to the portion, the outer surface corresponding to an exterior peripheral face of the sole; and

b) providing the portion into which the outer sole is partially impregnated with the woven natural textile material corresponding to less than the entire at least one surface of the inner sole so that only the inner sole is exposed on the outer surface of the sole corresponding to a remaining portion of the sole.

Therefore, the combination of the **OTIS ‘844** patent and the **HIRAOKA et al. ‘235** patent with regard to Amended Independent Claim 24 **do not show, disclose or teach** the specific structure of a footwear sole for a shoe, a slipper or a sandal and the like of the claimed invention.

It **would not** have been obvious to the manufacturer to provide woven natural textile material to the aforementioned step of “forming at one outer sole . . . peripheral face of the sole” and the step of “providing the portion into which the outer sole . . . to a remaining portion of the sole”, as these steps are unique processing steps.

Neither of the aforementioned prior art patents of **OTIS** and **HIRAOKA** disclose these specific steps.

The **OTIS ‘844** patent and the **HIRAOKA ET AL. ‘235** patent, even when combined, **do not teach or disclose** the following elements of Amended Independent Claim 27, for a footwear sole and a method for forming the same as follows:

a) forming at least one outer sole including at least partially impregnating a rubber-free, woven natural textile material into at least a portion of at least one surface of at least one inner sole so that only the textile material is exposed on an outer surface of a sole of the footwear article corresponding to the portion, the outer surface corresponding to an exterior peripheral face of the sole; and

b) providing the portion into which the outer sole is partially impregnated with the woven natural textile material corresponding to less than the entire at least one surface of the inner sole so that only the inner sole is exposed on the outer surface of the sole corresponding to a remaining portion of the sole.

It **would not** have been obvious to the manufacturer to provide woven natural textile material to the aforementioned step of “forming at one outer sole . . . peripheral face of the sole” and the step of providing the portion into which the outer sole . . . to a remaining portion of the sole”, as these steps are unique processing steps.

Neither of the aforementioned prior art patents of **OTIS** and **HIRAOKA** disclose these specific steps.

Therefore, the combination of the **OTIS ‘844** patent and the **HIRAOKA et al. ‘235** patent with regard to Amended Independent Claim 27 **do not show, disclose or teach** the specific structure of a footwear sole for a shoe, a slipper or a sandal and the like of the claimed invention.

## CONCLUSION

Thus, the prior art patents of **OTIS '844** and **HIRAOKA et al. '235**, even when combined, do not teach or disclose the claimed features of Amended Independent Claims 15, 24 and 27 and the Claims which depend therefrom. For these reasons, it is respectfully requested that Applicant's Claims 15 to 20 and 24 to 29 be allowed.

Respectfully submitted,  
**EZRA SUTTON, P.A.**

---

EZRA SUTTON  
Reg. No. 25,770

Plaza 9 Building, 900 Route 9  
Woodbridge, New Jersey 07095  
Ph: (732) 634-3520  
Fx: (732) 634-3511

ES/daw

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS  
BEING DEPOSITED WITH THE UNITED STATES POSTAL  
SERVICE AS FIRST-CLASS MAIL IN AN ENVELOPE  
ADDRESSED TO: COMMISSIONER FOR PATENTS,  
P.O. BOX 1450, ALEXANDRIA, VIRGINIA 22313-1450 ON

Date \_\_\_\_\_

By \_\_\_\_\_



July 6, 2007

**Via Fax 212-279-0774 & Mail**

Mr. Charles Mizrahi, President  
Wiesner Products, Inc.  
20 West 33<sup>rd</sup> Street, 4<sup>th</sup> Floor  
New York, NY 10001

Re: Our File: WIESNER 3.0-010  
U.S. Patent Appln No. 10/697,630  
Filed: October 29, 2003

**FOOTWEAR SOLE AND METHOD FOR FORMING THE SAME**

Dear Charles:

Enclosed is our Amendment we filed in response to the first Office Action dated December 29, 2006. Per your request, our firm took over this patent application file on May 31, 2007 from Kenyon & Kenyon of New York City. We filed this Amendment on June 29, 2007 and we had to pay a \$510 fee for a Three-Month Extension of Time, due to the delay of Kenyon & Kenyon not filing a response by the initial due date of March 29, 2007.

As you will note, we amended the claims to distinguish over the prior patents cited by the Examiner, and we also presented arguments explaining that the prior patents do not teach the invention, as set forth in the amended claims.

Also enclosed is our invoice for preparing and filing this Amendment, Power of Attorney, and Three-Month Extension of Time in the U.S. Patent Office. If you have any questions, please do not hesitate to call.

Sincerely yours,

EZRA SUTTON

ES:daw  
Enclosures